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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/079,555	02/19/2002	Masashi Watanabe	02097/LH	9145

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EXAMINER	
SINGH, SATWANT K	

ART UNIT	PAPER NUMBER
2625	

MAIL DATE	DELIVERY MODE
03/31/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/079,555	WATANABE, MASASHI	
	Examiner	Art Unit	
	SATWANT K. SINGH	2625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *11 February 2008*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,3,8,11,12 and 14* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1, 3, 8, 11, 12, and 14* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *11 June 2002* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 11 February 2008 has been entered.

Response to Arguments

2. Applicant's arguments with respect to claims 1, 8, and 12 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. Claim 1, 3, 8, 11, 12, and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Otsuka et al. (US 6,700,674) in view of Lytle et al. (US 6,993,563).

5. Regarding Claim 1, Otsuka et al teaches a facsimile apparatus comprising: a communication section which performs image data communication (Fig. 5, LAN controller 37) by transmitting a mail indicating image data via a mail transmission system (sending a facsimile transmission as email) (col. 12, lines 22-39); a section which writes an important mail flag when the user requests transmission of the image data (Fig. 6, mail flag 13g) (col. 11, lines 57-58); a printer (Fig. 5, printer 26) (col. 11, lines 15-30); a determining section (Fig. 6, communication result memory) which, if a delivery confirmation mail, which notifies whether delivery of the mail has succeeded or failed, has arrived, determines whether failure or a delivery success of the mail transmitted from the communication section (system returns an e-mail indicating non-delivery) (col. 18, lines 23-32), wherein the delivery confirmation mail includes the important mail flag if the important mail flag is written in the mail transmitted by the communication section (mail flag 13g is turned ON) (col. 17, lines 8-32); a control section which causes the printer to print an image based on the delivery confirmation mail if at least one of: (i) the important mail flag is included in the delivery confirmation mail and (ii) the determining section has determined that the delivery confirmation mail notifies the delivery failure (system returns an e-mail indicating non-delivery) (col. 17, lines 23-32), and which causes the printer not to print an image based on the delivery confirmation mail if both: (i) the important mail flag is not included in the delivery confirmation mail (Fig. 12, S410) (mail flag 13g is OFF) and (ii) determining section has determined that the delivery confirmation notifies the delivery success (no confirmation is made

concerning the presence or absence of mail indicating delivery) (col. 18, lines 23-32).

Otsuka et al fails to teach a facsimile apparatus wherein the section which writes the important mail flag in the mail is user operable to designate the mail as important when the user designates the mail as important via the user operable section.

Lytle et al teaches a facsimile apparatus wherein the section which writes the important mail flag in the mail is user operable to designate the mail as important when the user designates the mail as important via the user operable section (Figs. 21 and 28, Importance) (user designs a custom form and user may add "Importance" 2130, from the list to the custom form) (col. 28, lines 56-67, col. 29, lines 1-3).

Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to have combined the teachings of Otsuka with the teaching of Lytle to let the user determine the importance of the e-mail to be sent, to notify the recipient of the e-mail of it's importance and whether the e-mail needs any follow up action.

6. Regarding Claim 3, Otsuka et al teaches a facsimile apparatus, wherein the mail transmitted by the communication section comprises an e-mail, to which the image data attached as an attachment file, based on an e-mail protocol (format conversion of the image data into an e-mail format) (col. 12, lines 22-39).

7. Regarding Claim 8, Otsuka et al teaches a method of controlling a facsimile apparatus, wherein the facsimile includes; a printer (Fig. 5, printer 26)

(col. 11, lines 15-30), a communication section (Fig. 5, LAN controller 37) which performs image data communication, by transmitting a mail indicating image data via a mail transmission system (sending a facsimile transmission as email) (col. 12, lines 22-39), and a section which writes an important mail flag in the mail when the user requests transmission of the image data (Fig. 6, mail flag 13g) (col. 11, lines 57-58), the method comprising: determining, if a delivery confirmation mail, which notifies whether delivery of the mail has succeeded or failed, has arrived, whether the delivery confirmation mail notifies a delivery failure or a delivery success of the mail transmitted from the communication section (system returns an e-mail indicating non-delivery) (col. 18, lines 23-32), wherein the delivery confirmation mail includes the important mail flag if the important mail flag is written in the mail transmitted by the communication section (mail flag 13g is turned ON) (col. 17, lines 8-32); and causing the printer to print an image based on the delivery confirmation mail if at least one of: (i) the important mail flag is included in the delivery confirmation mail and (ii) it has been determined that the delivery confirmation mail notifies the delivery failure (system returns an e-mail indicating non-delivery) (col. 18, lines 23-32), and causing the printer not to print an image based on the delivery confirmation mail if both: (i) the important mail flag is not included in the delivery confirmation mail (Fig. 12, S410) (mail flag 13g is OFF) and (ii) it has been determined that the delivery confirmation notifies the delivery success (no confirmation is made concerning the presence or absence of mail indicating delivery) (col. 18, lines 23-32).

Otsuka et al fails to teach a method wherein the section which writes the important mail flag in the mail is user operable to designate the mail as important when the user designates the mail as important via the user operable section.

Lytle et al teaches a method wherein the section which writes the important mail flag in the mail is user operable to designate the mail as important when the user designates the mail as important via the user operable section (Figs. 21 and 28, Importance) (user designs a custom form and user may add "Importance" 2130, from the list to the custom form) (col. 28, lines 56-67, col. 29, lines 1-3).

Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to have combined the teachings of Otsuka with the teaching of Lytle to let the user determine the importance of the e-mail to be sent, to notify the recipient of the e-mail of it's importance and whether the e-mail needs any follow up action.

8. Regarding Claim 11, Otsuka et al teaches a method, wherein the mail transmitted by the communication section comprises an e-mail, to which the image data attached as an attachment file, based on an e-mail protocol (format conversion of the image data into an e-mail format) (col. 12, lines 22-39).

9. Regarding Claim 12, Otsuka et al teaches a facsimile apparatus comprising: communication means (Fig. 5, LAN controller 37) for performing image data communication by transmitting a mail indicating image data via a mail transmission system (sending a facsimile transmission as email) (col. 12, lines 22-39); means for writing an important mail flag in the mail when the user

requests transmission of the image data (Fig. 6, mail flag 13g) (col. 11, lines 57-58); means for printing an image (Fig. 5, printer 26) (col. 11, lines 15-30); means for determining, if a delivery confirmation mail, which notifies whether delivery of the mail has succeeded or failed, has arrived, whether the delivery confirmation mail notifies of a delivery failure or a delivery success of the mail transmitted by the communication means (system returns an e-mail indicating non-delivery) (col. 18, lines 23-32), wherein the delivery confirmation mail includes the important mail flag if the important mail flag is written in the mail transmitted by the communication means (mail flag 13g is turned ON) (col. 17, lines 8-32); means for controlling the printing means to print an image based on the delivery confirmation mail if at least one of: (i) the important mail flag is included in the delivery confirmation mail and (ii) the determining means has determined that the delivery confirmation mail notifies the delivery failure (system returns an e-mail indicating non-delivery) (col. 18, lines 23-32), and for controlling the printing means not to print an image based on the delivery confirmation mail if both: (i) the important mail flag is not included in the delivery confirmation mail (Fig. 12, S410) (mail flag 13g is OFF) and (ii) the determining means has determined that the delivery confirmation notifies the delivery success (no confirmation is made concerning the presence or absence of mail indicating delivery) (col. 18, lines 23-32).

Otsuka et al fails to teach a facsimile apparatus wherein the section which writes the important mail flag in the mail is user operable to designate the mail as

important when the user designates the mail as important via the user operable section.

Lytle et al teaches a facsimile apparatus wherein the section which writes the important mail flag in the mail is user operable to designate the mail as important when the user designates the mail as important via the user operable section (Figs. 21 and 28, Importance) (user designs a custom form and user may add "Importance" 2130, from the list to the custom form) (col. 28, lines 56-67, col. 29, lines 1-3).

Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to have combined the teachings of Otsuka with the teaching of Lytle to let the user determine the importance of the e-mail to be sent, to notify the recipient of the e-mail of it's importance and whether the e-mail needs any follow up action.

10. Regarding Claim 14, Otsuka et al teaches a facsimile apparatus, wherein the mail transmitted by the communication means comprises an e-mail, to which the image data attached as an attachment file, based on an e-mail protocol (format conversion of the image data into an e-mail format) (col. 12, lines 22-39).

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Lytle et al. (US 6,549,950) discloses in an electronic mail system environment, a system and method for automatically checking recipients' names,

providing message flags, providing message flags, providing custom forms, and providing an autoresponse feature.

Carlson et al. (US 7,010,606) discloses an electronic mails mail system environment, a system and method for automatically checking recipients' names, providing message flags, providing message flags, providing custom forms, and providing an autoresponse feature.

Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to SATWANT K. SINGH whose telephone number is (571)272-7468. The examiner can normally be reached on Monday thru Friday 8am - 4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David K. Moore can be reached on (571) 272-7437. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Satwant K. Singh
Examiner
Art Unit 2625

Sks

/David K Moore/
Supervisory Patent Examiner, Art Unit 2625